

## REMARKS

Claims 1-28 are pending. No claims are allowed. Claims 20-25 have been cancelled due to a restriction requirement. Figure 11 was amended to correct a typographical error. No new matter was added.

### Restriction

In the Office Action, the Examiner required a restriction between the following group of claims:

- I. Claims 1-19, 26-28, drawn to an apparatus for delivering hemostasis material.
- II. Claims 20-25, drawn to a method for promoting hemostasis.

Applicant hereby elects, with traverse, to prosecute the claims of Group I. The claims in Group II have been canceled without prejudice. Applicant reserves the right to pursue the claims in Group II, in a divisional application.

### Election

In the office action, the Examiner required an election of “a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable.” Specifically, the office action states that the “application claims directed to the following patentably distinct species of the claimed invention:

Figures 1, 2, 3A, 14, 15;  
Figure 3B;  
Figure 3C, 3D;  
Figure 3E;  
Figure 3F;  
Figures 3G;

Figures 4, 5, 6;  
Figures 7, 8, 9;  
Figures 10, 11, 12, 13.”

This requirement is respectfully traversed.

### The Claims

As presently constituted, there are 28 claims, of which 1, 13, 16, 20, 23 and 26 are independent. We will refer only to the independent claims as the claims that depend from them obviously are to be treated in the same manner with respect to the restriction requirement. Specifically, we will refer only to independent claims 1, 13, 16, and 26 in Group I pursuant to the restriction requirement above.

The Examiner restricted on the basis of Figures 1, 2, 3A, 14, 15; Figure 3B; Figure 3C, 3D; Figure 3E; Figure 3F; Figures 3G; Figures 4, 5, 6; Figures 7, 8, 9; and Figures 10, 11, 12, 13.

### Legal Threshold

The MPEP gives clear guidance for the issuance of a restriction. Under MPEP §806.04(b), “[s]pecies, while usually independent, may be related under the particular disclosure. Where inventions as disclosed and claimed are both (A) species under a claimed genus and (B) related, then the question of restriction must be determined by both the practice applicable to election of species and the practice applicable to other types of restrictions such as those covered in MPEP §806.05- §806.05(i). If restriction is improper under either practice, it should not be required.”

In order to sustain a proper restriction, the legal test is whether the individual groups are both “independent” and “distinct.” M.P.E.P. §808.01(a) and §806.05. First, “Independent” is

defined in the context of restriction as having “no disclosed relationship” or “unconnected in design, operation, or effect.”<sup>1</sup> The examples given in the M.P.E.P. are having different modes of operation, different functions or different effects.<sup>2</sup>

All the independent claims have numerous interrelated portions. A reading of independent claims 1, 13, 16, and 26 show that, by far, the similarities very much outweigh those things that are different. As such, independent claims 1, 13, 16, and 26 can be shown to be highly intertwined. Thus, Applicant is unclear why an election between species is required. The figures and claims perform similarly in operation, function, and effect.

Second, “Distinct” is defined in the context of restriction as having a relationship, but are “capable of separate . . . use as claimed.”<sup>3</sup> The distinctiveness prong is directed to combination-sub-combination type claims, process and apparatus for its practice, process and product made. . In this context, the restriction fails to meet this legal prong.

Furthermore, the guidelines are crystal clear. Examiners **must** provide reasons and/or examples to support conclusions. “A mere statement of conclusion is inadequate.”<sup>4</sup> In the paper, there is absolutely NO reason and or examples, only broad conclusory statements. The Examiner has provided to reasons or examples for this election requirement. Applicant is unclear as to the Examiner’s reasons for the election. As such, this falls extremely short of the required legal threshold.

Lastly, Although 35 U.S.C. 121 provides that restriction may be required to one or two or more independent and distinct inventions, 37 U.S.C. 1.141 provides that a reasonable number of

---

<sup>1</sup> MPEP §802.01

<sup>2</sup> MPEP §806.04

<sup>3</sup> MPEP §802.01

<sup>4</sup> MPEP §816

species may still be claimed in one application.<sup>5</sup> Since the legal threshold for a restriction is not met, it is respectfully asserted that this restriction is improper.

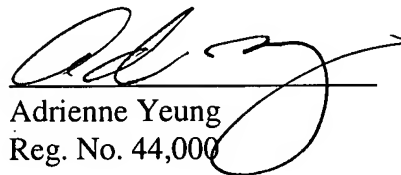
To further prosecution, Applicant elects Figures 1, 2, 3A, 14, 15. However, this election is made with traverse and applicant formally requests that the Examiner provide reasons for this restriction.

Summary

It is believed that this Amendment places the above-identified patent application into condition for allowance. Early favorable consideration of this Amendment is earnestly solicited.

Applicants respectfully request a supervisory review of the election and that the Examiner call the undersigned attorney at the number indicated below for an interview to expedite the prosecution of this application. Thank you.

Respectfully submitted,  
THELEN REID & PRIEST LLP

  
Adrienne Yeung  
Reg. No. 44,000

Dated: June 6, 2003

THELEN REID & PRIEST LLP  
P.O. Box 640640  
San Jose, CA 95164-0640  
(408) 292-5800  
(408) 287-8040

---

<sup>5</sup> MPEP §806.04(a)

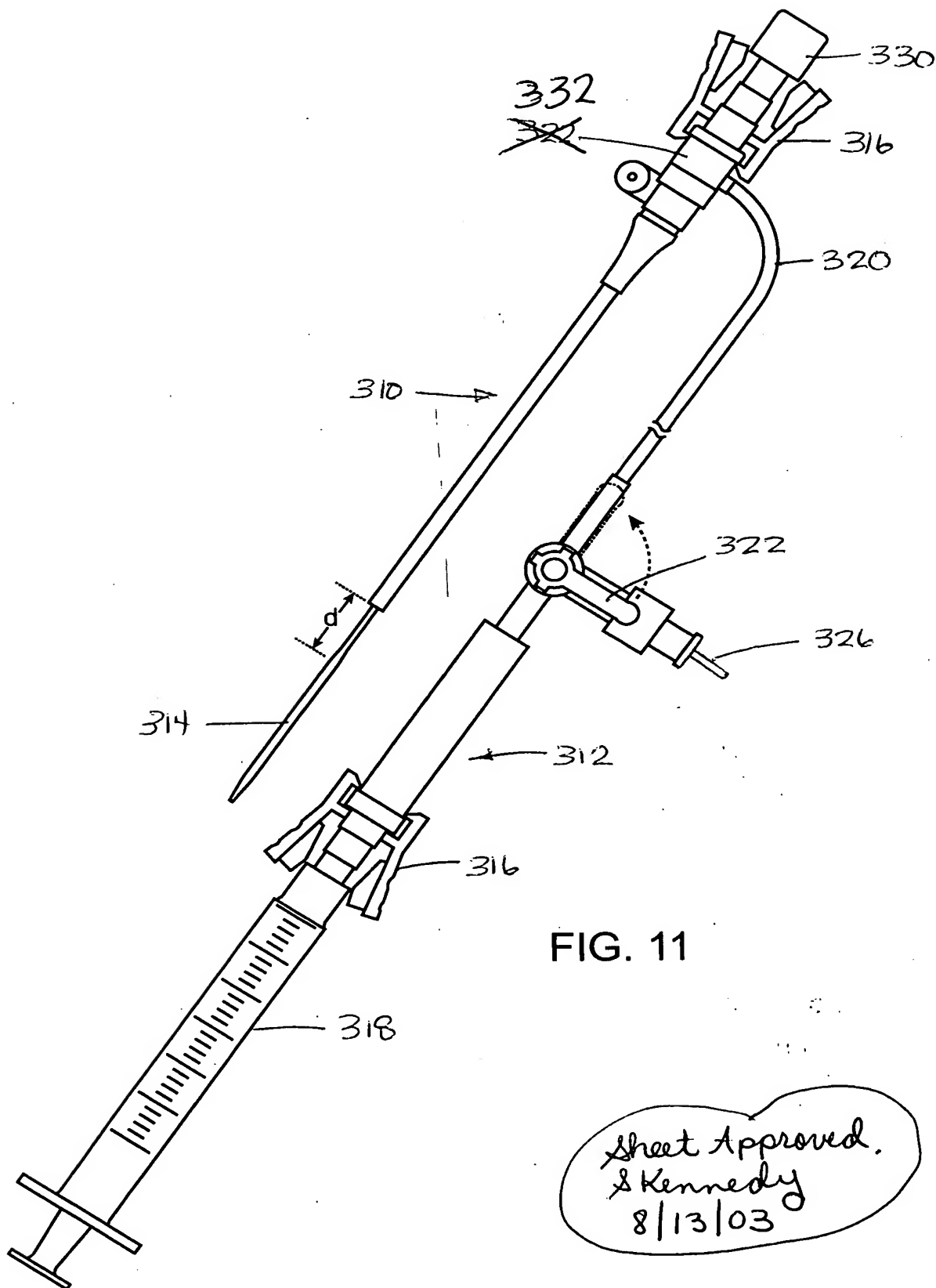


FIG. 11